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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,614	04/10/2001	Luis Eduardo Gutierrez-Sheris	25153-004	7999

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NEW YORK, NY 10036

EXAMINER

BARTLEY, KENNETH

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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01/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.	Applicant(s)
09/829,614	GUTIERREZ-SHERIS, LUIS EDUARDO
Examiner	Art Unit
Kenneth L. Bartley	3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 September 2007.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-30 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date: _____
5) Notice of Informal Patent Application
6) Other: _____

DETAILED ACTION

1. Receipt of Applicant's amendment and response filed on September 17, 2007 is acknowledged.

Response to Amendment

2. Claims have not been amended. Claims 1-30 are pending in the application and are provided to be examined upon their merits.
3. The Examiner acknowledges that Applicant's petition for benefit of earlier filing date has been granted. The Examiner also notes Applicant amended the specification on November 7, 2005. Applicant, however, also filed an Application Data Sheet that also needs to be amended as indicated in the prior Office Action under "Priority" heading.
4. The abstract was objected to because of length. Applicant has shortened the abstract, therefore the objection is removed.
5. The disclosure had minor objections. The Examiner thanks Applicant for fixing the problems and removes the objections.

Response to Arguments

6. Applicant's arguments filed September 17, 2007 have been fully considered but they are not persuasive. The Examiner provides reasons below.

7. **Applicant summarizes the prior art used in the Office Action dated March 16, 2007 on page 12, 2nd paragraph:**

Claims 1-10, 12-17, 20 and 24-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,120,608 to Gallagher, et al. ("Gallagher"), in view of U.S. Patent 6,039,250 to Ito et al. ("Ito"). Claims 11, 18, 19, 21-23, 29 and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher in view of Ito and in further view of U.S. Publ. No. US2002/0029193 to Ranjan and Shah ("Ranjan").

The Examiner summarized the relevant filing dates:

Applicants filing date (09/829,614): 04/10/2001
Provisional filing date: 1/05/2000

U.S. Patent 7,120,608 to Gallagher: 10/30/2000
U.S. Patent 6,039,250 to Hiroya: 07/06/1995
U.S. Pub. No. 2002/0029193 to Ranjan: 09/01/2000

It is submitted that neither Gallagher nor Ranjan is valid prior art with respect to the present application. First, it is noted that the present application has a filing date of April 10, 2001. Gallagher, which issued on October 10, 2007, is not prior art under either 102(a) or 102(b) and therefore can only be prior art only under 102(e) based on either its filing date of October 30, 2000, or its priority filing date of August 15, 2000. Similarly, Ranjan, which issued on March 7, 2002 from an application filed on August 31, 2001, can only be prior art only under 102(e) based on its priority filing date of September 1, 2000. In view of the foregoing discussion and the accompanying Petition to Accept an Unintentionally Delayed Benefit Claim, it is submitted that the present application is entitled to claim priority to U.S. patent application serial number 09/635,330, filed August 9, 2000, as well as to U.S. provisional application serial number 60/174,646, filed January 5, 2000. Accordingly, since the priority filing date of each of the claims of the present application is earlier than the earliest priority filing dates of either Gallagher or Ranjan, neither of these references is valid prior art with respect to the present application.

The Examiner notes that the current application is a continuation-in-part of application 09/635,330 (as filed by Applicant on 11/7/2005), Which itself claims the provisional application 60/174,646. Therefore, claims that are based on new matter do not receive the benefit of the earlier filing date, unless they are supported in the provisional application.

8. **The Examiner reviews the claims for support in the provisional application.**

Applicant's claim 1 teaches:

"said customer accessing said money-transfer service via said electronic communications network;

transmitting a data-input document from said money-transfer service to said customer via said electronic communications network;

said customer entering transaction data into said data-input document to record the amount of said sum of money to be transferred, an identification of said customer, an identification of said beneficiary, and basic payment data for said money-transfer service to use in collecting said sum of money;"

The Examiner is unable to find support in the provisional application for a customer inputting into a "data-input document" or for transmitting a document. The Examiner finds the provisional application describing a plurality of selling agents and selling locations where the money-transfer agency loads customer information into a transaction card (pg 4, lines 4-28 to pg. 5, lines 1-7). Therefore, the Examiner maintains the prior art rejection for claim 1.

Claims 14 and 25 also teach a data-input document or document means:

Claim 14 teaches a customer accessing a money service via internet and a data-input document:

"said customer accessing said money-transfer service via said Internet and an Internet-access device;

transmitting a data-input document from said online money-transfer service to said customer via said Internet ;

opening said data-input document on said Internet-access device;

said customer entering transaction data into said data input document to record the amount of said sum of money to be transferred, an identification of said customer, an identification of said beneficiary, and basic payment data for said online money-transfer service to use in collecting said sum of money;"

Claim 25 teaches a document means:

"a money-transfer service connected to said electronic communications network, said money-transfer service including document means, for transmitting transaction documents to said customers via said electronic

communications network, and database means, for storing transaction data received via said electronic communications network, and wherein said transaction data includes the amount of said sum of money to be transferred, an identification of said customer, an identification of said beneficiary, basic payment data for said money-transfer service to use in collecting said sum of money, and a fund-pick-up code; and

a plurality of customer communication systems connected to said electronic communications network, each of said customer communication systems comprising an access means, for receiving said transaction documents and said fund-pick-up code from said money-transfer service, a data-input means, for inputting transaction data into said transaction documents, a transmission means, for transmitting transaction data to said money-transfer service via said electronic communications network, a fund-pick-up means, for receiving said fund-pick-up code, and a beneficiary means, for informing 27 said beneficiary of said fund-pick-up code.”

Based on the above analysis, the Examiner maintains the prior art rejection since the claims are not supported by the provisional date. The dependent claims are rejected because they depend from their respective independent claims.

Application Data Sheet

9. The ADS is objected to because it needs to be updated for the priority (see MPEP §601.05 [R-5]).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-10, 12-17, 20, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,120,608 to Gallagher, et al., in view of U.S. Patent No. 6,039,250 to Ito and Hiroya.

Regarding applicant claim 1, 3, 8, 14, 20, 24 and 25,

- a. A method of transferring a sum of money from a customer to a beneficiary via a money-transfer service and an electronic communications network...

Gallagher, et al., discloses:

"Systems and Methods for Implementing Person-to-Person Money Exchange" (Title) and "...systems and methods for effecting online financial transactions between individuals or between individuals and entities such as banks, merchants and other companies." (col. 1, lines 52-55);

- b. said customer accessing said money-transfer service via said electronic communications network...

"...user accesses a fund exchange server to establish an online account, which is used to transfer funds..." (col. 1, lines 57-60). Access can be via desktop computer, which can be an internet access device (col. 4, lines 46-52).

- c. transmitting a data-input document from said money-transfer service to said customer via said electronic communications network...

The fund exchange server (money-transfer service) provides the user (customer) one or more web pages for establishing accounts and initiating transactions (col. 5, lines 45-50).

- d. said customer entering transaction data into said data-input document to record the amount of said sum of money to be transferred, an identification of said customer, an identification of said beneficiary, and basic payment data for said money-transfer service to use in collecting said sum of money...

The payor (customer) "...is prompted to enter an amount of funds for transfer and identification information for the recipient..." (where the recipient is the beneficiary) (col. 7, lines 33-40). Information can also include the sender's (identify the customer) name (col. 7, lines 60-65). Basic payment data, such as credit card information, is also provided when the account is established (col. 5, lines 64-67 and col. 6, lines 1-3).

- e. said money-transfer service collecting said sum of money in accordance with said basic payment data...

Funds are transferred to an online account from a funding account based on basic payment data (col. 5, lines 64-67 and col. 6, lines 1-3).

- f. providing said customer with a unique fund-pick-up code...

User (customer) can create an "identity confirmation query," which could be a unique code that the beneficiary must respond to (col. 7, lines 36-40).

- g. and informing said beneficiary of said unique fund-pick-up code...
The beneficiary needs to respond correctly to receive the funds, therefore, the beneficiary would have to be notified in some manner of the code.

Gallagher, et al., discloses additional system information including:

- i. **a fund exchange system that includes an electronic communication network (col. 4, lines 32-36).**
- ii. **fund exchange server connected to the communication network (Fig. 1).**
- iii. **pages and forms provided by a fund exchange server for transmitting (from customer) and receiving (to beneficiary) transaction documents (Figs. 3 and 5).**
- iv. **a database for storing information and data (col. 5, lines 64-66).**
- v. **client (customer and beneficiary) devices connected to a communication network (col. 4, lines 32-36); access provided by computers and cell phones (col. 4, lines 48-52).**

Although Gallagher, et al., provides for a confirmation query that can be used by a customer to transmit a unique pick-up code, he does not disclose the fund exchange server providing a pick-up code.

Ito and Hiroya, in the same field of endeavor, teach payment processes wherein they provide for a random number sequence as a security key (fund exchange server providing a pick-up code) (col. 4, lines 54-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have the fund exchange server of Gallagher, et al., provide an automated fund-pick-up code as disclosed by Ito and Hiroya, motivated by the fact that Ito and Hiroya provide for an “electronic money server” that includes a random number sequence as a security key and the fund exchange server could generate a random number and provide it to the customer as a pick-up code, thus eliminating the need for the customer to create the code (and saving time).

Regarding claims 2 and 26: The method of claim 1 wherein said electronic communications network includes the Internet, and the step of accessing said money-transfer service includes transmitting an access request from said customer to said money-transfer service via said Internet.

Gallagher provides that a fund exchange server is connected to a communication network that can include the internet (col. 4, lines 36-39).

Regarding claims 4 and 15: The method of claim 3 further including said customer having an IP (Internet Protocol) address and said money-transfer service recording said IP address in response to said customer accessing said money-transfer service.

Gallagher, et al., provides communication using the Internet by the payor (customer) with the fund exchange server which would require the fund server recording in some manner the payor's IP address (Microsoft Computer Dictionary, Microsoft Press, 5th Ed., 2002 pg. 287).

Regarding applicant claims 5 and 16: The method of claim 4 further including said money-transfer service creating a transaction record including said IP address, said transaction data and said unique fund-pick-up code.

Gallagher, et al., discloses that the user provides an e-mail address, mailing address, and/or "other information" as may be necessary, including transaction data, such as "amount to sent" (col. 5, lines 58-61 and Fig. 3). While an IP address is not specifically mentioned, it could be part of "other information" used to identify the customer.

Regarding claims 6 and 17: The method of claim 5 further including said money-transfer service transmitting a transaction confirmation request to said customer via said Internet.

Gallagher, et al., provides that payor (customer) "...is notified, preferably by an electronic message, that the payee has responded to the identity confirmation query." (col. 8, lines 23-26).

Regarding claim 7: The method of claim 6 wherein said electronic communications network includes the PSTN (Public Switched Telephone Network), and further including said customer contacting said money-transfer service via said PSTN to obtain said unique fund-pick-up code.

Gallagher et al., discloses user (customer) can use a cell phone (col. 4, lines 48-52) as well as a computer. It is well known in the art that cell phones and computers can use the PSTN.

Regarding claims 9, 10, 12, and 13:

(9) The method of claim 8 wherein the step of said customer contacting said money-transfer service via said PSTN includes said customer informing said money-transfer service of additional payment data.

(10) The method of claim 9 wherein said basic payment data includes an identification of a customer account at a payment institution, and the step of informing said money-transfer service of additional payment data includes revealing a unique payment code associated with said customer account.

(12) The method of claim 8 wherein the step of said customer entering data includes entering additional payment data.

(13) The method of claim 12 wherein said basic payment data includes an identification of a customer account at a payment institution, and the step of entering additional payment data includes entering a unique payment code associated with said customer.

Gallagher et al., allows that user can request additional money transferred to online account, by providing information such as account number, password, PIN number, etc. (col. 6, lines 26-32).

Regarding claim 27: The system of claim 26 wherein said Internet-access apparatus includes a web browser and a display, said money-transfer service includes a web-based server, and said document means includes means for transmitting said transaction documents as HTML (Hypertext Markup Language) documents capable of being rendered on said display via said web browser.

Gallagher et al., disclose that client devices include browsing programs (col. 4, lines 52-58) used on a monitor with a GUI interface (col. 4, lines 58-65). Also, "...content is typically presented to the user as a web page formatted according to downloaded JavaScript code and HTML code..." (col. 5, lines 31-34).

Regarding claim 28: The system of claim 27 wherein said electronic communications network includes the PSTN (Public Switched Telephone Network) and each of said

customer communication systems includes a DTMF (Dual-Tone, Multiple Frequency) access device connected to said PSTN...

Cell phones can contain DTMF (defined by phonescoop.com/glossary).

12. Claims 11, 18, 19, 21-234, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (11) above, in further view of Pub. No. US 2002/0029193 to Ranjan and Shah.

Regarding claims 11,18,19, 21-23, 29, and 30:

Although Gallagher, et al., discloses a cell phone, he does not disclose verbal communication or a method where the phone number is automatically provided (AIN).

Ranjan and Shah, in the same field of endeavor, teach a payment process using telephones that include a caller ID (AIN to match with customer phone number) and voice capability (para. 39 and 45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include an AIN and voice capability as disclosed by Gallagher and Ito, et al., as combined above, motivated by Ranjan and Shah who use such a caller ID and voice capability to enhance security and that these features will augment the security disclosed in the combined reference in section 11, where enhanced security is important given that money transfer is involved.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth L. Bartley whose telephone number is (571) 272-5230. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jagdish Patel can be reached on (571) 272-6748. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JAGDISH N. PATEL
PRIMARY EXAMINER